

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **F. William Studier** Confirmation No. **2367**
Serial No.: **10/675,936** Group No. **1636**
Filed: **September 30, 2003** Examiner: **N. S. Vogel**
For: **HIGH DENSITY GROWTH OF T7 EXPRESSION STRAINS
WITH AUTO-INDUCTION OPTION**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT
(37 CFR 1.121)**

Sir:

The present paper is submitted in response to the Notice of Non-Compliant Amendment (37 CFR 1.121) dated January 28, 2008.

Amendments to the Claims, which were previously presented in Applicant's paper dated November 5, 2007, are reflected in the listing of claims which begins on page 2 of this paper.

Remarks begin on page 5 of this paper.

Claim Listing:

This listing of claims will replace all prior versions and listings of claims in the application.

1. - 52. (cancelled)

53. (previously presented) A method for promoting auto-induction of transcription of cloned DNA in bacterial cells grown batchwise, which cells are selected from the group consisting of BL21(DE3), B834(DE3), HMS174(DE3) and derivatives thereof, said transcription being under the control of a *lac* or *lacUV5* promoter, the method comprising:

- a) providing a culture medium selected from the group consisting of ZYP-5052, PA-5052, P-5052, PASM-5052, MAS-15052, MS-15052, ZYM-15052 and combinations thereof;
- b) inoculating said culture medium with an inoculum of a said bacterial cells; and
- c) incubating the inoculated culture medium of step b) under conditions for growth of said cells until a saturating cell density has been achieved.

54. (previously presented) A method for promoting auto-induction of expression in T7 expression system host cells grown batchwise, which host cells comprise an expressible T7 RNA polymerase gene, which gene is under the control of a *lac* promoter, said method comprising:

- a) providing a culture medium selected from the group consisting of ZYP-5052, PA-5052, P-5052,

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PASM-5052, MAS-15052, MS-15052, ZYM-15052 and combinations thereof;

- b) inoculating said culture medium with an inoculum of a said host cells; and
- c) incubating the inoculated culture medium of step b) under conditions for growth of said cells until a saturating cell density has been achieved.

- 55. (previously presented) The method according to Claim 54 wherein said T7 expression system host cells are selected from the group consisting of Escherichia coli, Bacillus subtilis, Ralstonia eutrophus, Salmonella enterica serovar Typhimurium, Pseudomonads and Rhodobacter capsulatus T7 expression system host cells.
- 56. (previously presented) The method according to Claim 55 wherein the T7 expression system host cells are Escherichia coli T7 expression system host cells.
- 57. (previously presented) The method according to Claim 56 wherein the host cells are selected from the group consisting of BL21(DE3), B834(DE3), HMS174(DE3) and derivatives thereof.
- 58. (previously presented) The method according to Claim 54 wherein the T7 expression system host cells further comprise a target DNA in a T7 plasmid expression vector, which target DNA optionally comprises a coding sequence for a target protein.
- 59. (previously presented) The method according to Claim 58 wherein the target DNA is transcribed.

60. (previously presented) The method according to Claim 59 wherein the transcripts of the target DNA are translated into said target protein.

Remarks

Remarks regarding the rejection under 35 USC § 112, first paragraph, enablement and under 35 USC § 112, second paragraph were made in Applicant's paper dated November 5, 2007 and are not repeated here.

Provisional rejection on the grounds of nonstatutory obviousness-type double patenting:

In the Notice of Non-Compliant Amendment, the Examiner notes under 5. – Other that “applicants have not addressed the double patenting rejections on page 5-7 of the office action mailed 5/3/07, since applicants refer to a different application, i.e. 11/704,048, than those cited in the rejection.”

In a telephone interview with the Examiner on February 20, 2008, the Agent for the Applicant reported that the incorrect application serial number was quoted in the previously submitted amendment. The mistake was made inadvertently and without deceptive intent.

In the referenced telephone interview the Agent for the Applicant drew the Examiner's attention to the fact that, although the office action mailed 5/3/07 cites a provisional rejection of Claims 53-60 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claim 40** of copending Application No. 11/741,048, in view of Studier et al. (1986) or Studier et al. (1990), there is **no claim 40** in the cited application.

Because of the claim citation error in the office action of 5/3/07 and the errors in the Applicant's response of 11/5/07, the following remarks are submitted in a sincere effort to advance the case to a condition for allowance.

In the 5/3/07 paper, the Examiner provisionally rejected Claims 53 – 60 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 40 of copending Application No. 11/741,048, in view of Studier et al. (1986) and Studier et al. (1990).

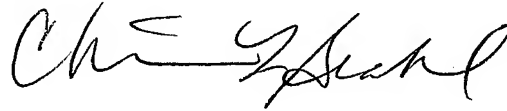
The Examiner has issued the same provisional rejection over claim 28 of the copending Application No. 11/741, 282, in view of Studier et al. (1986) and Studier et al. (1990).

In response, the Agent for the Applicant respectfully notes that the present application had a Claim 40 whereas in the referenced 11/741,048 application, claim 40 was cancelled in a preliminary amendment. Application serial number 11/741,048 is a divisional application drawing priority from this parent application in which, as filed, three (3) inventions were identified. Group III “drawn to a method for suppressing transcription of cloned DNA in bacterial cells grown batchwise . . .” is the subject matter of the 11/741,048 invention and was comprised of original claims 30-39. Therefore the Agent for the Applicant submits that this provisional rejection is rendered moot by the preliminary amendment cancellation of the originally filed Claim 40 in application 11/741,048. Based upon the Examiner's remarks of pages 5 – 7 of the 5/3/07 paper, the Applicant's Agent suggests that the first provisional rejections may refer to Claim 1 of co-pending Application Serial Number 11/741,282.

In regard to the provisional rejection under claim 28 of copending 11/741,282 in an effort to advance the present case to a condition for allowance, the Agent notes that Application No. 11/741,282 derives its priority from the case presently under examination. The Agent further notes that the two applications have the same named inventor who was (and remains) under the obligation of assignment to the common owner of the two applications. Therefore, should Claims 53 – 60 of the present application be found allowable and should the claims of the referenced Application No. 11/741,282 also be found allowable, the Agent shall be please to enter a terminal disclaimer in the second-to-be-allowed case.

In closing, the Applicant submits that the present application is now in condition for allowance and respectfully anticipates receipt of a timely Notice of Allowance.

Respectfully Submitted,



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